PATENT

Attorney Docket No. DOW-31481-A

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	:	Wei-Kuo Lee et al.
Serial No.	:	10/813,367
Filing Date	:	March 30, 2004
For	:	CABLE SEMICONDUCTING SHIELD
Confirmation No.	:	4720
Group Unit	:	2831
Examiner	:	Nguyen, Chau N.
Customer No.	:	29423

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted via the Patent Electronic Filing System (EFS) at the U.S. Patent and Trademark Office.

Date: October 18, 2006

Jere Palmatier

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

This brief replies to the Examiner's Answer mailed August 18, 2006. In the Examiner's Answer, the Examiner relied solely on the precedent case *ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) to dismiss the unexpected synergistic effects of the invention as currently claimed. *See* pages 7-8. This reliance on legal precedent is in error.

First, sole reliance on legal precedent is not applicable when the applicant has demonstrated the criticality of the specific limitations. *See* MPEP §2144. In this case, the Appellants have shown unexpected results arising from the use of the specific levels of carbon nanotube and carbon black specified in the claims. As such, applying the *Obiaya* approach is inappropriate in this case. Indeed, applying *Obiaya* as the Examiner has done would vitiate the entire concept of unexpected results supporting the patentability of "selection inventions" where the Appellants have demonstrated unexpected results such as "sweet spots" or other improved performances.

Second, reliance on legal precedent is not applicable if the facts are not sufficiently similar. *Id.* Even more, the Appellants believe that the Examiner must rely on all applicable

legal precedents if he is going to rely on any legal precedent. The Appellants have shown that the facts in the *Obiaya* case are not sufficiently similar to the facts in this case especially when *Obiaya* is viewed in the light of related legal precedent. The Appellants have also shown in their responses to offices actions and in the appeal brief that the legal cases that underlie the *Obiaya* decision clearly limit the scope of that decision. Indeed, the most relevant precedent case, *In Re Wilder,* indicates that the *Obiaya* approach does not always pertain to claims drawn to compositions. The Appellants believe that the facts in this appeal are more similar to the facts in *In Re Wilder* than they are to the facts in *In Re Obiaya.* Therefore, the Examiner is using the wrong precedent to dismiss the showing of unexpected results. If the Examiner used the correct precedent, the unexpected results would be properly considered and the claims would be allowable.

Furthermore, the Examiner has not refuted the Appellants' other precedent cases nor the logic and conclusions flowing from those cases. Indeed, the Examiner in the Examiner's Answer failed to even mention these other precedent cases. Therefore, the Appellants' position on the proper precedent for this case stands unrebutted by the Examiner.

For the reasons above, plus the reasoning presented in more detail in the Appeal Brief, the Examiner's objections must be reversed.

The Appellants believe that no fees are due with the submission of this Reply Brief. However, please charge any fees that may be due to Deposit Account No. 23-2053 and consider any necessary petition as provisionally made.

Respectfully submitted,

Date: October 18, 2006

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